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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,878	09/11/2003	Kevin J. Zilka	SVIPGP002B	8771
28875	7590	10/08/2004	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,878

Applicant(s)

ZILKA ET AL.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 1103.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on September 11, 2003.

Claims 1-19 are currently pending in this application.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on June 7, 2004 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, in Claim 1, the applicant indicates that an identifier is determined. What is the identifier identifying and what determines the identifier? What is a notes field? What is an existing identifier?

It is unclear what the applicant means by "wherein the identifier is determined by selecting an existing identifier," "wherein the identifier is determined by adding the identifier," "and wherein the identifier is determined utilizing a pull-down menu." What does the applicant mean by "wherein the identifier are identified by searching a database?" The applicant states in Claim 1, "allowing the manually selection of a file and storing the manually selected file in association with the identifier." What does the applicant mean by manually selection of a file and how are the files stored in association with the identifier?"

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-17 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computer implemented". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claims 1-6:

Rivette discloses a method for organizing patents utilizing a computer-implemented system,
comprising:

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determining an identifier (Fig. 12B (1201), Fig. 12H, Fig. 13-17, Fig. 111, Fig. 125 (Document #), Fig. 127 (12612), page 15 [0385-0386], page 25 [0603];

displaying a notes field for receiving manually entered notes (Fig. 7 (714) Figs. 125 (12520, 12522), 134 (13410, 13412) page 14 [037], page 15 [0380];

storing the manually entered notes in association with the identifier (Fig. 134 (13408), Fig. 125, page 15 [0380-0381]);

allowing the manually selection of a file (Fig. 125) ;

storing the manually selected file in association with the identifier (Fig. 134 (13408), Fig. 125);

and

associating a plurality of patents with the identifier (page 15 [0384-0385];

wherein the manually entered notes, the file, and the patents are accessible by

subsequent selection of the identifier (page 15 [0384-0385]),

Referring to Claim 7:

Rivette discloses a method wherein the notes field allows a user to cut and paste Notes (Fig. 117 (11728), 135-137)).

Referring to Claim 8:

Rivette discloses a method wherein the file is selected utilizing a file structure field (Figs. 4, 6].

Referring to Claim 9:

Rivette discloses a method wherein the file structure field includes a file tree-structure (page 2 [0026], Fig. 157, Fig. 164, Fig. 171, Figs. 179-184).

Referring to Claim 10:

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Rivette discloses a method wherein the file structure field allows a user to browse various folders where files have been previously stored (, page 11 [0211], Fig. 153).

Referring to Claim 11:

Rivette discloses a method wherein the file structure is displayed simultaneously with the notes field on the same interface (Fig. 117, 118, page 15 [0376]).

Referring to Claim 12:

Rivette discloses a method wherein the patents associated with the identifier are identified by searching a database (Fig. 121).

Referring to Claim 13:

Rivette discloses a method wherein the database is a comprehensive database of all patents issued by at least one government agency (Search Results Figures 141-143, 147 (all US Patents, page 7 [0255], page 15 [0376])).

Referring to Claim 14:

Rivette discloses a method wherein a mapping is generated based on the patents associated with the identifier (Fig. 157).

Referring to Claim 15:

Rivette discloses a method wherein the mapping includes a technology mapping (Fig. 2 (206), page 2 [0025], page 7 [0258], [0261-0262, 0264], page 8 [0266-0268], page 13 [0346]).

Referring to claim 16:

Rivette discloses a method wherein the mapping depicts a plurality of categories of technology utilizing a graphical user interface (Fig. 29, Fig. 2 (206), page 2 [0025, 0026], page 7 [00258, 0261, 0262, 0264], page 8 [0266-0268]).

Referring to Claim 17:

Rivette discloses a method wherein the mapping displays statistics regarding the patents in each of the categories of technology (Fig. 2 (206), page 2 [0025], page 7 [0258], [0261-0262, 0264], page 8 [0266-0268], 0273)).

Referring to Claim 18:

Rivette discloses an intellectual property data structure stored on a computer readable medium,

comprising:

an identifier object (page 15 [0380-0387});

a notes object correlated with the identifier object for tracking manually entered notes (page 15 [0380-0387]); and

at least one patent object correlated with the identifier object for tracking a plurality of patents (page 15 [0380-0387]).

Referring to Claim 19:

Rivette discloses 19. A method for organizing patents utilizing a computer-implemented system, comprising:

determining an identifier (Fig. 12B (1201), Fig. 12H, Fig. 13-17, Fig. 111, Fig. 125 (Document #), Fig. 127 (12612), page 15 [0385-0386], page 25 [0603]

displaying a notes field for receiving manually entered notes (Fig. 7 (714) Figs. 125 (12520, 12522), 134 (13410, 13412) page 14 [037], page 15 [0380];

storing the manually entered notes in association with the identifier (Fig. 134 (13408), Fig. 125, page 15 [0380-0381]);

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allowing the manually selection of a file (Fig. 125);

storing the manually selected file in association with the identifier (Fig. 134 (13408)); and

associating a plurality of patents with the identifier (page 15 [0384-0385]);

wherein the manually entered notes, the file, and the patents are accessible by

subsequent selection of the identifier (page 15 [0384-0385]);

wherein the notes field allows a user to cut and paste notes (Fig. 117);

wherein the file is selected utilizing a file structure field including a file tree-
structure that allows a user to browse various folders where files have been previously
stored, where the file structure is displayed simultaneously with the notes field on the
same interface (Fig. 4, 6, page 2 [026], Figs. 157, 164, 171, 179-184);

wherein the patents associated with the identifier are identified by searching a
database including a comprehensive database of all patents issued by at least one
government agency (Search Results – Figures 141-143, 147, page 7 [0255], page 15[0376]);

wherein a mapping is capable of being generated based on the patents
associated with the identifier (Fig. 157).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

IBM discloses a web-based secured method and system for collaboration of inventions.

Open Ideas discloses a database for free ideas sharing.

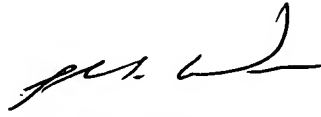
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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